
REMARKS

In the Office Action mailed June 24, 2008, the Examiner is requiring an election as between allegedly patentably distinct species:

- Species A Elect a DNA species selected from the group consisting of SEQ ID NOS: 1-6;
- Species B Elect a PNA species selected from the group consisting of SEQ ID NOS: 7-24;
- Species C Elect a LNA species selected from the group consisting of SEQ ID NOS: 25-33;

Applicants traverse the requirement for the election of a species. This application is a United States national stage filing under 35 U.S.C. §371; accordingly, this application is subject to the "unity of invention" standard as set forth in 37 CFR 1.475. With regard to unity of invention, MPEP § 1893.03(d) states:

"The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding *special technical feature*. **The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.**" (MPEP §1893.03(d), emphasis added.)

In requiring the election of a species, the Examiner reasons:

"The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The species recited as a DNA species corresponding to SEQ ID NOS: 1-6 are structurally and physicochemically distinct one from the other. Likewise, the PNA species corresponding to SEQ ID NOS: 7-24 are structurally and physicochemically distinct one from the other and the LNA species are structurally and physicochemically

distinct one from the other. The sequences of the different species are additionally structurally distinct from the other. Likewise, the different sequences of the DNA species, the PNA species and the LNA species can function irrespective of each other and each of the other species." (Office Action dated June 24, page 3.)

As quoted above, the expression "special technical features" is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. MPEP §1893.03(d). The present invention relates to the discovery of improved methods for the reverse transcription and/or amplification of nucleic acids.

It is clear from the application as filed that the claims share a unifying special technical feature which confers novelty over the art, i.e., improved expression analysis by selectively suppressing the reverse transcription (RT) and/or amplification (of a product of RT) of at least one unwanted nucleic acid in a pool of nucleic acids. This is useful to eliminate contaminating and/or unwanted highly-expressed nucleic acids, for example, globin-mRNA transcripts from a whole blood sample, from subsequent downstream analysis.

Furthermore, Applicants note that the Examiner has not cited any art and therefore has no basis to assert that the species lack a unifying special technical feature, which is defined as technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.

The species cited by the Examiner as not relating to a single general inventive concept are merely preferred embodiments of the molecular species (for selectively suppressing the reverse transcription of at least one unwanted mRNA and/or for selectively suppressing the amplification of a product of the reverse transcription of at least one unwanted mRNA) to be used in the general inventive concept. In fact, it is clear from the specification that many of the recited species are intended to be used together. For example, see Examples 4-9, found on pages 22-31 of Applicants' specification, which set forth experiments using various combinations of PNAs complementary to alpha 1-globin and 2-globin mRNA and beta 1-globin and 2-globin mRNA.

Accordingly, Applicants submit that the species characterized by the Examiner as not relating to a single general inventive concept under PCT Rule 13.1 are in fact related to a single general inventive concept having a special technical feature, and that the Examiner's characterization based on different structure is purely academic.

As noted in section 1850 (II) of the MPEP:

"Although lack of unity of invention should certainly be raised in clear cases, *it should neither be raised nor maintained on the basis of a*

narrow, literal or academic approach....rigid rules cannot be given and each case should be considered on its merits, the *benefit of any doubt being given to the applicant*." MPEP §1850 (II).

Accordingly, Applicants request reconsideration of the election requirement in view of the foregoing remarks and the unifying special technical feature apparent in the claims.

Conclusion and Provisional Election

Applicants submit that in view of the foregoing amendments and remarks all the pending claims are seen to relate to a single inventive concept, and the claims are in a form and are of the sort that is properly viewed as relating to a single invention that should not be restricted. Applicants request that the restriction (election of species) requirement of the Office Action of June 24, 2008 be reconsidered and withdrawn.

Although, for reasons set forth above, Applicants believe that the restriction is improper and uncalled for, and without in any way acquiescing in the reasons for the requirements set forth in the Office Action, but in order to be fully responsive to the Office Action, Applicant elects SEQ ID NO: 2, i.e., 5'TAA CGG TAT TTG GAG - phosphate group - 3' for initial examination. Claims 1-33, 39, and 40 read on the elected species.

Rejoinder

As noted by the Examiner:

“Upon the allowance of a generic claim, **applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claims** as provided by 37 CFR 1.141.” (Office Action dated June 24, 2008, emphasis added.)

Additionally, Applicants direct the Examiner’s attention to MPEP 806.04(d), which states:

“Once a claim that is determined to be generic is allowed, **all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim**, since the additional species will depend thereon or otherwise include all of the limitations thereof.” (Emphasis added.)

Respectfully submitted,



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